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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/085,169	02/25/2002	Jose Castillo Deniega	IFLOW.063DV1	3825
20995	7590	02/28/2005	EXAMINER	
KNOBBE MARTENS OLSON & BEAR LLP			LAM, ANN Y	
2040 MAIN STREET			ART UNIT	
FOURTEENTH FLOOR			PAPER NUMBER	
IRVINE, CA 92614			1641	

DATE MAILED: 02/28/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/085,169

Applicant(s)

DENIEGA

Examiner

Ann Y. Lam

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 14 December 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-3,5-8,11 and 12 is/are pending in the application.
- 4a) Of the above claim(s) 4 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-3,5-8,11 and 12 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## DETAILED ACTION

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1, 2, 5-7 and 11 are rejected under 35 U.S.C. 102(b) as being anticipated by Lampropoulos et al., 5,817,072.

As to claims 1 and 5, Lampropoulos et al. discloses an elongated tube having a plurality of exit holes increasing in size along the length of the catheter (column 7, lines 57-67), so that a fluid flowing therein will flow through substantially all of said exit holes at a substantially equal rate (column 7, lines 57-67), a lumen of said catheter having a cross-sectional flow area, said exit holes having a non-variable, combined cross-sectional flow area less than the flow area of the lumen so that the exit holes define a flow restricting orifice of the catheter (column 8, lines 8-13), the catheter being formed from a material that is non-reactive to anatomical system. (Since the slots are normally in a closed position, the cross-sectional area of the slots are considered to be smaller than the cross section area of the lumen.)

As to claim 5, since Lampropoulos discloses such a catheter, Lampropoulos therefore discloses the steps of manufacturing the catheter, including the step of providing exit holes having a non-variable size.

As to claims 2 and 6, the holes are provided throughout the circumference of the catheter (see figure 6).

As to claims 7 and 11, the exit holes are in at least one row aligned with a longitudinal axis of the catheter (see fig. 16.)

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claim 3 is rejected under 35 U.S.C. 103(a) as being unpatentable over Lampropoulos et al., 5,817,072.

Lampropoulos discloses the invention substantially as claimed (see above), except for the specific diameter of the exit holes.

The diameter of the exit holes that would achieve the optimum results, i.e., the most uniform delivery of fluids, as taught by Lampropoulos, can be discovered through routine experimentation and thus would be obvious. It has been held that where the general conditions of a claim are disclosed in the prior art, discovering the optimum or workable ranges involves only routine skill in the art. *In re Aller*, 105 USPQ 233.

Claims 8 and 12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lampropoulos et al., 5,817,072, in view of Stevens, 5,536,261.

Lampropoulos et al. disclose the invention substantially as claimed (see above). Lampropoulos teaches that the catheter is useful for providing fluid to the central venous system (col. 3, lines 21-23.) However, Lampropoulos does not teach that the catheter has a closed distal end.

Stevens, discloses a catheter having openings for fluid delivery in the circulatory system. Stevens teaches that the catheter has a closed distal end which encourages lateral flow as would be desirable for fluid delivery in the circulatory system (col. 2, lines 35-37.) It would have been obvious to provide a closed end as taught by Stevens on the Lampropoulos catheter because Stevens teaches that a closed distal end provides the advantage of encouraging lateral flow desirable for delivering fluid in the circulatory system, which includes the central venous system.

### ***Response to Arguments***

Applicant's arguments filed December 14, 2004 have been fully considered but they are not persuasive.

In response to applicant's argument that the Lampropoulos reference does not disclose or suggest holes having a non-variable cross-sectional flow area, a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed

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invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. In a claim drawn to a process of making, the intended use must result in a manipulative difference as compared to the prior art. See *In re Casey*, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 136 USPQ 458, 459 (CCPA 1963).

In this case, the Lampropoulos holes are capable of being non-variable. The holes are considered non-variable when they are not varying, for example, when no fluid is going through them. Examiner suggests Applicant amend the claims to recite structural limitations to distinguish over the prior art.

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ann Y. Lam whose telephone number is 571-272-0822. The examiner can normally be reached on M-Sat 11-6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Long Le can be reached on 571-272-0823. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

A.L.



LONG V. LE  
SUPERVISORY PATENT EXAMINER  
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02/22/05